

REMARKS

Claims 35-42 are pending in this application. By this Amendment, claims 28-34 are canceled and new claims 35-42 are added. Support for the new claims may be found, for example, in the original claims and pages 2 and 3, page 6, lines 2-5, and page 8, lines 26-29, of the present specification. No new matter is added. In view of at least the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

I. Restriction Requirement

The Office Action asserts that it may restrict claim 34 from claim 33, if no further arguments are submitted in response to the Restriction Requirement. By this Amendment, claims 33 and 34 are canceled, rendering the Restriction Requirement moot and the election of claim 33 or 34 unnecessary.

II. Rejections under 35 U.S.C. §112

The Office Action rejects claims 28, 30, and 34 (and dependent claims with similar limitations) under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement; and rejects claims 30 and 34 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. By this Amendment, claims 28-34 are canceled, rendering their rejection moot.

Applicants have considered the 35 U.S.C. § 112 rejections in the outstanding Office Action and the Office Action dated February 13, 2009. In response, Applicants have further clarified some of the language of the claims and also address the Examiner's concerns as follows.

The MPEP indicates that when a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possesses the claimed invention, the written description requirement is satisfied. See MPEP §2163(I). This

possession may be shown by any number of ways and the Applicant need not describe every claim feature exactly because there is no *in haec verba* requirement. See MPEP §2163(I)(b). Rather, to satisfy the written description requirement, all that is needed is "reasonable clarity." See MPEP §2163.02. Also, an adequate description may be made in any way through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae. See MPEP §§2163(I), 2163.02.

Applicants also note that the MPEP §2163 clearly indicates that "[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient")."

Furthermore, Applicants note that the fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. See MPEP §2173.05(b).

In response to the rejection regarding the claimed forwarding size upper limit (previously recited in claim 30, now recited in claim 37), Applicant's respectfully submit that the present specification provides support for the claimed setting unit on page 3, lines 22-24, page 6, lines 2 and 3, and page 8, lines 12-14. Because the setting unit and forwarding page number upper limit 15 description in these sections of the present specification as a reference value for the maximum number of pages for the converted facsimile data, a skilled artisan

would have understood 1) what is claimed and 2) that the inventor was in possession of the claimed setting unit that sets a maximum corresponding to the number of pages of the facsimile data as of the filing date of the application.

Regarding the first, second, third, and fourth determining units in claims 41 and 42, Applicants note that support for the first and second determining unit may be found, for example, on page 10, lines 12-14 and 20-25. This section teaches that *"analyzing unit 7 analyzes a received email, and obtains information on the presence/absence of a forwarding instruction, a forwarding destination and a sender's address from the received email (Step S301)."* The cited section of the specification also teaches that "[w]hen the sender's address is registered to the address book 12 (YES in Step S304), the email analyzing unit 7 permits the fax-forwarding, and the email analyzing unit 7 converts the received email into facsimile data (Step S305)." Applicants respectfully submit that a skilled artisan would have understood the inventor to be in possession of the claimed first and second determining unit, based on the teachings of the specification. The present specification also provides support for the third and fourth determining units on, for example, page 10, lines 20-25, and page 11, lines 12-32. Support for the claimed selection unit may be found, for example, on page 10, lines 20-25, and page 12, lines 1-24. Lastly, support for the claimed reporting unit may be found, for example, on page 13, lines 7-21.

For at least these reasons, one of ordinary skill in the art would 1) recognize that the Applicants were in possession of, as of the filing date of the application, the features of the new claim and 2) be able to ascertain the meaning of terms recited in the claims in light of the specification and, thus, the requirements of 35 U.S.C. §112 are satisfied. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

III. Rejections under 35 U.S.C. §103(a)

The Office Action rejects claims 28-31 and 33 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,859,967 ("Kaufeld") in view of U.S. Patent No. 6,982,803 ("Eguchi") and U.S. Patent No. 7,009,725 ("Miyanaga") and further in view of U.S. Patent No. 6,211,972 ("Okutomi");¹ rejects claim 32 under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaufeld in view of Eguchi, Miyanaga, Okutomi, and further in view of U.S. Patent No. 6,771,382 ("Misawa") and U.S. Patent No. 6,373,598 ("Matsumoto"); and rejects claim 34 under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaufeld in view of Eguchi, Miyanaga, Okutomi, and further in view of U.S. Patent Application Publication No. 2002/0054335 ("Sekiguchi") and U.S. Patent Publication No. 2004/0128207 ("Ray"). By this Amendment, claims 28-34 are canceled, rendering their rejection moot. Reconsideration and withdrawal of the rejections are respectfully requested.

IV. New Claims

By this Amendment, new claims 35-42 are presented. Newly added independent claims 35 and 38 recite "a splitting unit that splits the facsimile data converted by the converting unit into a plurality of split facsimile data when the facsimile data converted by the converting unit exceeds the forwarding size upper limit; and a split forwarding unit that forwards the plurality of the split facsimile data split by the splitting unit to the facsimile machine of the facsimile-forwarding destination indicated by the facsimile-forwarding instructing information separately, wherein the *split forwarding unit receives other data during splitting and forwarding the facsimile data.*" The applied references fail to disclose,

¹ Claims 29-31 and 33 are addressed on pages 15-17 of the Office Action. However, these claims are not included in the statement of the rejection over Kaufeld in view of Eguchi, Miyanaga, and Okutomi on page 8 of the Office Action.

suggest, or establish any reason or rationale to provide such a combination of features required in claims 35 and 38 (and their dependent claims).

Furthermore, regarding claim 41, the applied references fail to disclose or suggest "a selection unit that selects a facsimile-forwarding destination indicated by the facsimile-forwarding instructing information if the first determining unit determines that the email received by the email receiving unit includes the facsimile-forwarding instructing information, or selects a facsimile-forwarding destination registered by the registering unit if the first determining unit determines that the email received by the email receiving unit does not include the facsimile-forwarding instructing information and the second determining unit determines that the facsimile-forwarding destination to which the email is permitted to be facsimile-forwarded corresponding to the sender of the email is registered by the registering unit," as recited in claim 41.

For at least these reasons, the applied references (considered either alone or in combination) fail to teach, suggest, or establish any reason or rationale to provide the combination of features recited in independent claims 35, 38, and 41, from which claims 36, 37, 39, 40, and 42 variously depend. Accordingly, Applicants submit that claims 35-42 are patentable over the applied references. Prompt examination and allowance of new claims 35-42 are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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